

REMARKS

An Office Action was mailed on November 6, 2003, and declared Final. Claims 1-18 are pending in the present application.

Applicant is submitting an IDS for the consideration of the Examiner.

Claims 1-9, 12 and 14-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of Baerlocher et al. '573, while claims 10, 11, 13 and 18 are further rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of Baerlocher et al. '573 in further view of DeMar et al. '660. Responsive thereto, Applicant has amended all claims to recite that the player is allowed to choose one of the prize sets only (see Figure 3 for example). Thus, when the player is offered a choice of two or more different prize sets, the player is allowed to choose one prize set only. This feature clearly distinguishes the amended claims from the prior art such as Baerlocher, since in Baerlocher a player is not permitted to choose the wheel they wish to spin. Claim 1 has also been amended to incorporate the features of claim 5 and to clarify there the same number of possible outcomes in each prize set, which feature is also provided in claims 14 and 17 and all remaining claims through dependency. Thus, all claims now require that the player is allowed to choose one of the prize sets only and to clarify there the same number of possible outcomes in each prize set.

Reconsideration is respectfully requested.

In Baerlocher '573, the player is obliged to spin the first wheel in the hierarchy of three wheels. Further, in Baerlocher, a player is not restricted to choosing one prize set only. If the player succeeds in getting the appropriate bonus indication on the first wheel in the hierarchy of three, only then does the player spin the second prize set displayed on the second wheel in the hierarchy of three wheels. Claim 1 has further been amended to clarify that the total theoretical return to the player is the same regardless of the prize set the player chooses (page 5, lines 1-3 of the specification). Again, this is clearly not disclosed or suggested in Baerlocher. In Baerlocher, the theoretical return from spinning the third reel which contains the jackpot is clearly much

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greater than spinning the first, although as discussed above, the wheels are spun in series and the player cannot choose a wheel, as such.

The present invention teaches a feature game in which a bonus prize is awarded on the occurrence of a predetermined triggering event in an underlying game. For the feature game, the player may select the chosen volatility of the feature game. That is to say, the player may select a prize set which provides a good chance that the player will win a relatively small prize, or may select a prize set which offers a greater prize but with a much reduced likelihood or something in between the two extremes. The prize sets are arranged so that the total theoretical return to the player is the same regardless of the prize set the player chooses (page 5, lines 1-3 of the specification). That is important, because otherwise the theoretical return to a player from playing the gaming machine, could not be predicted and the machine could breach gaming regulations in various countries and states.

There are a large number of games implemented on electronic gaming machines, including "spinning reel games", "card game", "keno games", "pachinko games", "roulette games" etc. Games are often themed to distinguish them from other games. All of these games compete with each other to attract a player's attention. For the operator of a gaming machine venue, it is important to have gaming machines which will attract players and which will interest a player and which will be popular with the patrons of those gaming machine venues. For a gaming machine manufacturer it is important to devise games which are popular with players as this improves sales of their products, helps them retain their customers and helps them attract new customers. Often very minor differences between games can have a significant impact on the popularity of that game and consequently on the performance of the gaming machine manufacturer. Existing games have minimal player input. Therefore, very subtle changes to a game whereby more player input is involved, greatly heightens player enjoyment and encourages play of such games at the expense of other games having lesser player input. When a game having greater player input is provided, greater patronage of the venues occurs improving the turnover of the venue as well as improving the profitability of the supplier of gaming machines providing such games.

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In the present case, the additional player input which is provided is that the player is allowed to select the volatility of their feature game. Although the difference may seem slight, it is in fact, a critical factor in increasing player enjoyment and patronage of the particular game. It is also not fairly disclosed or suggested in any of the prior art cited by the Examiner.

With respect to O'Halloran '883, this reference discloses a variation on a well known "double up" event which has been used in electronic gaming machines for many years both in spinning reel type games and most commonly in gaming machines playing poker style card games and variations thereof. Typically, such "double up" events work as follows. Whenever any sort of win on the underlying game is achieved, instead of banking the win, the player is offered the chance to double their win. Typically, to double their win, the player has to predict whether a card shown face down on the screen is red or black. Often the "double up" event will display the previous three or four cards drawn to provide the player with historical information which may help them to guess the color of the suit of the next card. The player then presses a red or black button, depending on whether they think that the face down card is red or black. If the player guesses the color of the card correctly, their win is doubled. If the player guesses incorrectly, the win is forfeited. The chances of winning are 50%. If the player wins the "double up" event, it is usual for the player to be offered an opportunity to double the now doubled win, again by predicting the color of the next face down card in the sequence. If the player guesses correctly, the doubled win is doubled, effectively quadrupling the win on the underlying game. If the player guesses incorrectly, the player loses all the doubled win. A successful player is typically allowed to double a win up to three or four times, and thus has the potential to multiply the original win on the underlying game by eight or sixteen times. The double up feature is commonly used by players, when the player makes a small win on the underlying game to make the win more meaningful. Were the player to be awarded a large win on the underlying game, for say a royal flush, it is unlikely that the player would risk loosing that win on a double up game.

O'Halloran is simply a minor variation on the double up event in which instead of guessing the color of a card, the player has to guess the location of a joker, but the event works in a similar way and its purpose is the same. In particular, it is noted that in O'Halloran, any

winning combination in the base game, results in the bonus game of O'Halloran being triggered (see column 3, lines 17-20, "*if there is a winning combination on any of the win lines, then the supplemental or bonus game feature is entered*"). Although to a degree, the player is allowed to take a greater or lesser gamble when considering whether to try and multiply their win on the base game by either two times, three times or four times, in reality, the O'Halloran game is an incremental development of the well known existing double up games. For example, a player of a gaming machine with a double up game, could obtain a similar risk and reward pattern as the O'Halloran "X 4" gamble by simply doubling up in the double up game twice. One skilled in the art, and the player, will see O'Halloran as a minor variation on existing double up events.

The disclosure and purpose of the bonus game of Baerlocher is very different from that of O'Halloran. O'Halloran routinely and regularly provides a player of a base game, a bonus game in which it is possible for them to double, triple or quadruple an underlying win with the appropriate odds. In stark contrast, Baerlocher is a feature game is a game which is intended to offer a very small chance of winning a very large jackpot at odds of eight million to one. In Baerlocher, only on average every fiftieth play does a player gets to play the feature game spinning a series of three wheels of fortune in a hierarchical fashion. The only similarity between Baerlocher and O'Halloran is that they both disclose electronic gaming machines. The purposes and performance of the machine of Baerlocher and the machine of O'Halloran, are entirely different. O'Halloran is a gaming machine which will pay out small amounts on a fairly regular basis on an underlying game, but does not pay a major jackpot. Baerlocher is concerned with providing an massive jackpot but at very low odds for the player. On a wheel of fortune, odds of eight million or more to one could be achieved in two different ways. It could be achieved by having a single spinning wheel with eight million segments (either physical or virtual such as the virtual reel invention disclosed in US Patent 4,448,419 to Telnaes)), or for having a hierarchy of spinning reels with a particular result on a first spinning reel entitling the player to spin a second spinning reel which also requires a particular result upon achievement of which the player spins a third reel for a single chance of achieving a jackpot. The odds can be adjusted by adjusting the number of segments on the first, second and third reels and by adjusting the chance of entering the bonus game in the first place. Typical odds are provided in

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the abstract of Baerlocher which discloses overall odds of winning a jackpot of one to eight million.

The player of O'Halloran, will be looking for regular relatively small wins on the underlying game with an opportunity to multiply underlying wins on the underlying game, a small number of times which feature is likely to be particularly utilized where the underlying win is relatively small. In contrast, the player of Baerlocher is looking for a very large win but is prepared to accept that the odds of achieving that win will be extremely poor. Baerlocher teaches away from O'Halloran as it provides a single bonus game with extreme volatility.

To the person skilled in the art, a "double event" which O'Halloran is clearly a variation of, is a completely different event to a "feature game" which is what is clearly disclosed in Baerlocher. That is to say:

1. Double up is a generic event that appears in many games regardless of what themes or bonus features they have.
2. Double-up is a 100% theoretical return to player feature that is always dependent upon a win in the base game and the size of that win. In contrast, feature games have variable return to player percentages that form part of the overall theoretical return to player of the game.
3. For double-up the player is offered a choice whether to play after a win. As it is dependent upon that win occurring and has a 100% theoretical return to player, whether the player chooses to play or not does not affect the overall theoretical return to player of the machine. In contrast, features games are automatic and occur after pre-determined trigger events in the base game (not necessarily winning events), and independent of the size of any win. Hence, the outcome of those features can affect and is factored into the calculation of the overall theoretical return to player of the game.

For the reasons set forth above, one skilled in the art would not think to combine the teachings of O'Halloran and Baerlocher et al. as they relate to completely different aspects of the gaming machine performance. Neither does either Baerlocher or O'Halloran suggest or teach the

suggested combination as currently claimed. In fact, they teach away from being different types of bonus games.

Further, Baerlocher teaches the spinning of the spinning reels in hierarchical fashion and therefore, even if the unlikely combination were made in the resultant combined machine, the player would not be offered the choice of three wheels of different volatility. Rather the combination of O'Halloran and Baerlocher would result in a player on winning a bonus game, being offered the opportunity to spin the wheels of fortune described in Baerlocher in a hierarchical fashion, one after another, as per the teaching of Baerlocher. Thus, even in the unlikely event that the person skilled in the art did combine O'Halloran and Baerlocher, he or she would not arrive at the present invention as claimed. Instead, the combination of O'Halloran and Baerlocher would result in a player, after every winning event, being obliged to spin the first of the three wheels of Baerlocher in hierarchical fashion and only being allowed to spin the second and third wheels on the occurrence of a particular event during the spin of the first or second wheel.

Even if the players of the combined O'Halloran/Baerlocher gaming machine were, in fact, allowed to chose the particular wheel to spin and there is no suggestion or teaching in either document that would lead one skilled in the art to create such a combination, one skilled in the art would appreciate that there is no point in combining Baerlocher with O'Halloran in that way since players would always choose the wheel with the highest return, i.e. the third jackpot wheel in Baerlocher. Hence it would make no sense to combine Baerlocher with O'Halloran if the wheels were not spun in a hierarchical fashion. Instead, the person skilled in the art would provide the third wheel only and omit the first and second wheels since they would never get chosen by the player.

Yet further, any gaming machine venue operator operating the combination of Baerlocher and O'Halloran as envisaged, either with a hierarchy of three wheels or just the third wheel would quickly go bankrupt since people would spinning the jackpot wheels whenever a winning combination occurred in O'Halloran which would occur many more times than the once in fifty plays envisaged in Baerlocher.

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Thus, Applicant respectfully submits that the fundamental proposition behind the combination of O'Halloran and Baerlocher is highly unlikely as asserted by the Examiner as the two references teach away from each other and the only thing that they have in common, is that they both relate to electronic gaming machines. Further, were a person skilled in the art to combine the two documents together, they would not be combined in the manner envisaged by the Examiner and would not result in an invention as presently claimed in the claims of the subject application.

Accordingly, it is respectfully submitted that the prior art fails to teach or reasonably suggest a gaming machine comprising a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets from which the player is allowed to choose only one prize set, each set containing a plurality of prize outcomes, including non-winning prize outcomes, and wherein each prize set has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player, wherein the prize is drawn from the prize set selected by the player and wherein the prize outcomes are independent of any prize awarded in the underlying game on the occurrence of the predefined triggering event and wherein at least one of the prize sets displays at least two different winning outcomes and wherein the total theoretical return to the player is the same regardless of the prize set the player chooses, as set forth in claim 1 and claims 2-4 and 6-13 through dependency.

Applicant also respectfully submits that the prior art fails to teach or reasonably suggest a gaming machine comprising a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets, the player being allowed to choose only one of the prize sets, each set

containing a plurality of prize outcomes, one or more of the prize sets including non winning prize outcomes, and wherein including the non winning prize outcomes, each prize set has the same number of potential outcomes, from which prize sets a prize is to be drawn and awarded to the player, by a random process, the sets of prizes being presented on segments of wheels, wherein the prize is drawn from the wheel selected by the player and wherein the prize outcomes are independent of any prize awarded in the underlying game on the occurrence of the predefined triggering event and wherein at least one of the prize sets displays two different winning outcomes and wherein the total theoretical return to the player is the same regardless of the prize set the player chooses, as set forth in claim 14 and claims 15-16 through dependency.

Finally, Applicant respectfully submits that the prior art fails to teach or reasonably suggest a gaming machine comprising a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets from which the player is allowed to choose only one prize set, each set containing a plurality of prize outcomes, and wherein each prize set has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player, wherein the prize is drawn from the prize set or sets selected by the player and wherein the prize outcomes are independent of any prize awarded in the underlying game on the occurrence of the predefined triggering event, as set forth in claim 17 and claim 18 through dependency.

For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-4 and 6-18, consisting of independent claims 1, 14 and 17 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner

is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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